

REMARKS

This amendment is in response to the outstanding Official Action mailed on June 23, 2003, the shortened statutory period for filing a response being set to expire on September 23, 2003. A two-month extension of time, extending the time period for filing a response until November 24, 2003, is also submitted herewith. Claims 2-38 are pending in the application, of which claims 27-32 are allowed; claims 2-4, 11-22 and 33-38 are rejected; and, claims 5-10 are objected to.

Initially, Applicants wish to thank the Examiner for the courtesy of a telephonic interview on October 21, 2003. Applicants' attorney, April M. Mayo, contacted Examiner Hartman to discuss possible claim amendments that would place the application in condition for allowance. In view of those discussions, and the subsequent amendments, the application is now believed to be in condition for allowance.

**I. CLAIM AMENDMENTS**

Independent claim 17 has been amended to recite that the thickness ratio of the adhesive layer to the wear layer ranges from 1:3 to 1:7. Because there is support in the specification for the amendment, Applicants submit that no new matter has been added.

Independent claim 19 has been amended to recite that the adhesive material is applied and adhered to the fixed road surface in a partially molten state, and that the adhesive layer is of a sufficient thickness to melt into irregularities in the road surface so as to increase the surface area between the marking and road surface, and that the wear layer has a first application temperature which is higher than a second application temperature of the adhesive layer. Applicants submit that there is support in the specification for the amendment, and that no new matter has been added.

Independent claim 21 has been amended to recite that the thickness ratio of the adhesive layer to the wear layer ranges

from 1:3 to 1:7, and that the adhesive layer is applied to the fixed road surface in a partially molten state. Applicants submit that there is support in the specification for the amendment, and that no new matter has been added.

Independent claim 33 has been amended to recite that the adhesive layer is applied to the fixed road surface in a partially molten state when the surface marking is heated. Applicants submit that there is support in the specification for the amendment, and that no new matter has been added.

Applicants have canceled withdrawn claims 23-26 but preserve their right to file a continuation application at a later date.

## **II. CLAIM REJECTIONS**

The Examiner has rejected claims 2-4 and 17-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,676,488 ("Hedblom") in view of U.S. Patent No. 4,248,748 ("McGrath"). Applicants assert that the newly rewritten claims are not obvious in view of Hedblom and/or McGrath. As will be discussed more fully herein, Hedblom and/or McGrath do not teach or suggest the limitations of the present claims. Namely, Hedblom, alone or in combination with McGrath does not teach that (a) the adhesive layer is applied to the road surface in a partially molten state; (b) the adhesive layer is of a sufficient thickness to melt into the irregularities in the road surface area; (c) the thickness ratio of said adhesive layer to said wear layer ranges from 1:3 to 1:7; and/or (d) the wear layer has a first application temperature which is higher than a second application temperature of the adhesive layer. Because each of the newly amended independent claims include one or more of the aforementioned limitations, Hedblom, alone or in combination with McGrath, cannot be used to support the Examiner's obviousness rejection.

**A. The Combination of Hedblom and McGrath Fail To Teach Or Suggest The Limitation of Independent Claims 17, 19, and 21, That The Road Surface Marking Must Have An Adhesive Layer of a Distinct Thickness**

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As recognized by the Examiner, Hedblom fails to disclose a heat-activatable adhesive to adhere a road surface marking to a road surface. See Official Action dated 6/23/03. Moreover, even if the adhesive of McGrath is combined with the surface marking of Hedblom, McGrath fails to teach that the road surface marking of Applicants' invention has a distinct thickness.

McGrath teaches a species of an adhesive layer comprising the combination of a pressure sensitive adhesive acrylate polymer and a tackifying resin. McGrath focuses on the properties of adding a tackifying resin to produce a unique combination of properties, including tailored amounts of room-temperature preadhesion. (col. 2, ls. 18-25)

McGrath does not teach or suggest that because the surface marking has a thick adhesive layer, as compared to a mere coating, the heat activatable adhesive layer will melt and penetrate into irregularities in pores of the receiving surface so as to increase the specific surface area between the marking and the receiving surface. Moreover, McGrath does not teach that the thickness ratio of the adhesive layer to the wear layer ranges from 1:3 to 1:7. (Applicants' invention, page 7) Rather, as discussed, McGrath primarily focuses on teaching the combination of the pressure sensitive adhesive and tackifying resin.

Furthermore, Applicants note that in the interview with the Examiner, the Examiner suggested that further limiting the claim to include the thickness ratio of the adhesive layer to the wear layer may be sufficient to distinguish over McGrath and/or Hedblom. Consequently, Applicants contend that McGrath, in combination with Hedblom, does not teach that there is a thickness ratio of the adhesive layer to the wear layer ranging

from 1:3 to 1:7, as set forth in claims 17 and 21. Additionally, there is no teaching or suggestion that the adhesive layer is of a sufficient thickness to melt into the irregularities or pores of the road surface, as set forth in claim 19.

**B. The Combination of Hedblom and McGrath,  
Does Not Teach Or Suggest The Limitation  
Of Claim 19 That The Application  
Temperatures Of The Adhesive Layer And  
Wear Layer Differ**

McGrath does not discuss the application temperature of a heat-activated adhesive if it were to be combined with a road-marking surface. In contrast, Applicants' road surface marking teaches that the adhesive layer has a lower application temperature than the upper wear layer. This is because the upper layer has a higher softening point, more structural viscosity, high viscosity and is harder than the lower adhesive layer. (See specification, page 7.) The lower layer has a lower softening point, lower yield limit, less or no structural viscosity, lower viscosity and is softer than the upper layer. (See specification, pages 7-8.) In this regard, McGrath does not teach or suggest that the application temperature of the heat-activated adhesive layer differs from the application temperature of the surface marking or wear layer to which it is applied. Moreover, McGrath does not teach or suggest that the wear layer has a first application temperature which is higher than a second application temperature of the adhesive layer.

Similarly, Hedblom does not discuss the differences in temperature between the adhesive layer and the upper wear layer. At best, Hedblom discusses the curing of the first and second topcoat. Specifically, Hedblom states that "[t]he same heat simultaneously accomplishes the next step of preparing the first topcoat (a thermoplastic) to achieve the skid-resistant particles 36 by heating and softening the thermoplastic material." (col. 11, ls. 15-24) However, Hedblom does not continue on to discuss

the application temperatures of the adhesive and wear layer needed to apply the surface marking to the road surface.

Consequently, Hedblom, alone or in combination with McGrath, does not teach the limitation of claim 19 that the application temperature of the wear layer is higher than the adhesive layer.

**C. The Combination of Hedblom and McGrath Does Not Teach or Suggest The Limitation Of Claims 19, 21, and 33 That The Adhesive Layer Must Be Applied In A Partially Molten State**

Applicants' invention teaches that the lower layer may be applied in a partially molten state to melt down into the irregularities in the road surface. (See specification, page 7.) Hedblom, alone or in combination with McGrath, does not teach that the adhesive layer may be applied in a partially molten state when the surface marking is heated. Rather, as discussed above, Hedblom generally teaches a road surface marking, and McGrath provides no specific teachings or suggestions regarding the specific properties of the adhesive layer disclosed by Applicants' invention.

As it is believed that all of the rejections set forth in the Official Action have now been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

Application No.: 09/896,795

Docket No.: ALBIHN W 3.0-414

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

By April M. Mayo  
April M. Mayo  
Registration No.: 54,298  
LERNER, DAVID, LITTENBERG,  
KRMHOLZ & MENTLIK, LLP  
600 South Avenue West  
Westfield, New Jersey 07090  
(908) 654-5000  
Attorney for Applicants

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